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DAVID A JACKSON ESQ
KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK NJ 07601

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OFFICE OF PETITIONS

In re Application of :
Friedman et al. :
Application No. 09/686,647 : ON PETITION
Filed: 10 October, 2000 :
Atty Dckt No. 600-1-087CIP/DIV/COM :

This is a decision on the petition filed on 1 February, 2001, and supplemented by facsimile on 8 April, 2003, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application be accorded a filing date of 10 October, 2000, with Figure 3 described in the specification. The petition was recently forwarded to the Office of Petitions, and the Office apologizes for the delay and regrets any inconvenience to petitioners.

The petition is dismissed.

The application was filed on 10 October, 2000. However, on 28 November, 2000, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 10 October, 2000, and advising applicants that Figure 3 described in the specification appeared to have been omitted.

In response, the present petition was filed on 1 February, 2001 (certificate of mailing date 25 January, 2001).

The Office file is the official record of the papers originally filed in this application. A review of the official record reveals that no drawing Figure 3 was filed with the original application papers. Where the records of the Office (e.g. the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in the absence of convincing evidence (e.g. a

postcard receipt under MPEP 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office. It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.¹ This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

On 8 April, 2003, petitioners supplied by facsimile a copy of their postcard receipt. Unfortunately, in this case, petitioners' postcard receipt fails to properly itemize the papers allegedly filed in this application. The postcard receipt does not itemize the number of sheets or figures of drawings filed, or the filing of any drawings at all. A postcard receipt will not serve as prima facie evidence of receipt in the USPTO of any items which are not properly itemized and identified.

It is noted that the transmittal sheet located in the Official file states that this application is a continuation of prior application No. 09/686,647, and that the application as filed is a true copy of the prior application. Petitioners' assertion that Figure 3, which was omitted on filing and a part of a copending application mentioned on the application transmittal sheet is a part of the original disclosure, is not persuasive. A review of the record reveals that the specification, as filed, described drawings of Figures 1-23. The drawings as filed, however, do not contain Figure 3. Clearly Figure 3 was intended to be a part of this application. Whether Figure 3 was a part of a copending application is not an issue here since the copending application was not specifically incorporated by reference into

¹ The public was afforded a "reminder" of the then extent post card receipt practice at 857 *Off. Gaz. Pat. Off.* 667 (O.G.) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the O.G. that contains important O.G. notices of continuing relevance.

the disclosure of this application.² The mere reference to another application is not an incorporation of anything therein into the application containing the reference.³ To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. Figure 3 was simply not filed in the USPTO on 10 October, 2000. Matter included in Figure 3 may be submitted as an amendment for consideration by the examiner under MPEP sections 608.02(p) and 608.04. In view of the above, the application cannot be accorded 10 October, 2000, as the application filing date with the drawing of Figure 3 as a part of the original disclosure.

Furthermore, the declaration of counsel's employee, Joan A. Santucci, that the papers filed on 10 October, 2001, included Figure 3 is not more persuasive than the contents of the official USPTO file. The statement was made nearly four (4) months after the events in question and recite personal remembrances of the preparation and filing of the application with the PTO. The application does not appear to be unusual and it is not understood why the filing of this particular application would stand out in such detail in the affiant's memory, particularly in view of the fact that affiant prepared and mailed similar papers to the PTO on a routine, daily basis. Likewise, the application transmittal sheet evidences, at best, petitioner's intent to file three (3) sheets of drawings.

Petitioner should also note that since the specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) are not limited to a reproduction or "true copy" of the prior application, the safeguard in former 37 CFR 1.60(b) concerning the filing of an application lacking all of the pages of the specification or all of the sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b). Nevertheless, an applicant may incorporate by reference the prior application, by including, in the application-as-filed, a statement that such specifically enumerated prior application or

²See MPEP 608.01(p).

³See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).

applications are "hereby incorporated by reference."⁴ As such, petitioners' claim that the specification and drawings filed in the present application are a "true copy" does not amount to incorporation by reference of the prior application and does not permit petitioners to amend the continuing application to include subject matter in the prior application.

Nevertheless, it is noted that the specification states that the present application is a continuation-in-part of prior application No. 08/292,345 (now United States Patent No. 6,001,968) which is specifically incorporated by reference.

MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Figure 3 is not new matter if it was a part of the disclosure of the prior application which was incorporated by reference.

Lastly, petitioners should note that there is no provision in 37 CFR 1.53(b) for requesting transfer of application papers from one application to another. Each application must be complete in itself.⁵ Petitioners should therefore file Figure 3 as a preliminary amendment. If Figure 3 is filed as a preliminary amendment, it will be reviewed by the Examiner for new matter.

The application will be returned to Technology Center 1600 for further processing with a filing date of 10 October, 2000, using only the papers present in the USPTO on the date of deposit.

⁴ See MPEP 201.06(c).

⁵ See 37 CFR 1.4(b).

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

A handwritten signature in black ink, appearing to read "D Wood". The signature is stylized with a large, looped "D" and a cursive "Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions